TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No. YOR920000475US1

In Re Application Of: **Dimitri Kanevsky, et al.**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/777,077	February 5, 2001	Matthew S. Gart	23389	3625	9551

Invention: **SYSTEM AND METHOD FOR SOFTWARE SELLING**

COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on **December 21, 2004**

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Signature

Dated: **February 22, 2005**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Dimitri Kanevsky, et al.

Examiner: Matthew S. Gart

Serial No: 09/777,077

Art Unit: 3625

Filed: February 5, 2001

Docket: YOR920000475US1 (13823)

For: SYSTEM AND METHOD FOR SOFTWARE SELLING

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Pursuant to 35 U.S.C. 134 and 37 C.F.R. 41.37, entry of this Appeal Brief in support of the Notice of Appeal filed December 21, 2004 in the above-identified matter is respectfully requested.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

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Date: February 22, 2005

John S. Sensny

I. Statement of Real Party in Interest

The real party in interest in the above-identified patent application is the International Business Machines Corporation.

II. Statement of Related Proceedings

There are no prior or pending appeals or interferences related to this application to Appellant's knowledge.

III. Statement of Supporting Evidence

Applicants are not relying on any affidavits, extrinsic documents or extrinsic evidence.

IV. Statement of Claim Status and Appealed Claims

A. Claim Status

Claim 1 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 10 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 11 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 12 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 13 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 14 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 15 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 16 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 17 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 18 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 19 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 20 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 22 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 23 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 24 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 25 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 26 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 27 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 28 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 29 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

Claim 30 stands rejected based on 35 U.S.C. §103 and U.S. Patent No. 6,041,316.

B. Appealed Claims

Claims 1, 10-20 and 22-30 are appealed. A clean copy of these claims is contained in Appendix A to this Appeal Brief.

V. Statement of Amendment Status

No amendments are pending in this application. The last Amendment filed in this case was dated August 16, 2004. That Amendment has been entered.

VI. Statement/Explanation of Invention

The present invention, generally, relates to methods and systems to encourage users (107) to purchase software applications (106) after they have been provided with a demonstration or trial version (specification, page 1, lines 7-9; Fig. 4, step 400). In accordance with the invention, after the user (107) receives the trial or demonstration version, the performance of that trial or demonstration version is gradually diminished over time (specification, page 4, lines 7-9; Fig. 4, step 402). With this procedure, when the application performance is being reduced, the user (107) is able to continue using the trial or demonstration version of the application and can become reliant thereon (specification, page 2, line 26 - page 3, line 1). At the same time, the user's desire to have the full performance of the application causes him or her to purchase the product (specification, page 3, line 1; Fig. 4, step 403).

Various specific ways may be used to diminish the performance or appearance of the compute application. For example (specification, page 5, lines 12-16), this may be done by degrading a network bandwidth, by degrading the processing speed, by producing tactile stimulus such as vibrations, or by producing unpleasant olfactory stimulus.

VII. Statement/List of Each Ground for Review

1. Rejection under 35 U.S.C. 103 based on U.S. Patent 6,041,316

a. The rejection

Claims 1, 10-20 and 22-30 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent 6,041,316 (Allen).

b. U.S. Patent 6,041,316

Allen discloses procedures for delivering data over a communications network in a manner that encourages users to pay royalties for the use of the data. This is done by providing the user with a partially degraded version of a product, without requiring any payment of a royalty fee; and then, providing a higher quality version of the product if the user pays the appropriate fees. Allen, from column 7, line 47 to column 8, line 57, describes various ways to partially degrade the product. For example, the product may be degraded by filtering out major or key portions of the data, or by adding noise. Also, one or more portions of the data could be encrypted.

c. Appellants request that Claims 1, 14, 17, 20 and 24 be separately reviewed.

The following features of the claims are not disclosed in or suggested by Allen.

i) The means to change the appearance or performance of the specified application includes means to degrade a network bandwidth, as described in Claim 1.

ii) The step of using a second set of instructions to diminish the performance of the main program by degrading the processing speed of the computer, as described in Claim 14.

iii) The means for diminishing the performance of the main program includes means to degrade a network bandwidth, as described in Claim 17.

iv) The step of diminishing the performance of the trial version includes the step of producing tactile stimulus, a described in Claim 20.

v) The means to change the appearance or performance of the specified application includes means to produce unpleasant olfactory stimulus, as described in Claim 24.

d. Argument

Much of the Examiner's reasoning for rejecting the claims is common to all the claims. Accordingly, Appellants arguments for reversing the rejections include some arguments common to all of the claims and some arguments specific to Claims 1, 14, 17, 20 and 24. Appellant will first present the common arguments, and then present the arguments specific to Claims 1, 14, 17, 20 and 24.

The Examiner agrees that Allen does not disclose the above-listed features described in Claims 1, 14, 17, 20 and 24 of this application. (Office Action dated September 21, 2004, pages 3 and 4; page 5, lines 21 and 22; page 6, lines 1-6). The Examiner's rational for rejecting these claims based on Allen is that "it would have been obvious to a person skilled in the art to have modified the method of Allen to have included any number of means to change the appearance or performance of the specified application." (Office Action dated September 21, 2004, page 4, lines 16-18).

The rejection of Claims 1, 14, 17, 20 and 24 is not proper because the above-quoted statement of the Examiner does not justify the rejection. Assuming for the sake of argument that it would have been obvious to modify Allen to include any number of ways to change the specified application, it does not follow that every modification to Allen for this purpose would have been obvious.

Appellants are not claiming "any number of modifications." Instead, Appellants are claiming several specifically defined modifications. The relevant question is not whether any number of modifications would have been obvious, but whether those specifically claimed modifications would have been obvious. And, Appellants contend, the specific modifications expressly described in Claims 1, 14, 17, 20 and 24 would not have been obvious.

The Court of Appeals for the Federal Circuit has taught that:

"an 'obvious to try' standard is not a legitimate test of patentabiliy...The statutory standard of 103 is whether the invention, considered as a whole, would have been obvious to one skilled in the art, not whether it would have been obvious to one skilled in the art to try various combinations." N.V. Akzo v. E.I. duPont deNemours & Co., 1 USPQ2d 1704, 1707 (Fed Cir. 1987).

In support of the rejection of the claims, the Examiner also notes that the present application discloses that the program may be degraded in any one or more of a number of ways. (Office Action dated September 21, 2004, page 3, lines 3-6). This is correct. It does not follow that every one of these ways would have been obvious to those of ordinary skill in the art. There are obvious ways and non-obvious ways to degrade the program. The ways that are described in Claims 1, 14, 17, 20 and 24 are non-obvious.

This is because the ways described in these claims to change the specified program or application are of a different type than the ways disclosed in Allen.

Generally, the Allen procedures relate to the way the computer application looks or sounds to a user, while the techniques described in Claims 1, 14, 17, 20 and 24 relate more to the practical functionality of the program to the user. These latter techniques are of utility because they more strongly encourage a user to purchase the application while still allowing the user comparatively full use of the diminished application but in an impractical way.

Claims 1 and 17

For instance, degrading the network bandwidth, as described in Claims 1 and 17, allows full use of the computer application, but at a slower speed. The user is not denied any functionality. The user can fully complete any projects, and the user is not left in a situation where an unfinished project cannot be completed. At the same time, the user is provided with a clear incentive to purchase the computer application. Because of the difference in kind between the features described in Claims 1 and 17 and the type of features disclosed in Allen, neither of these claims would have been obvious to one of ordinary skill in the art.

Claims 14 and 20

Likewise, the reduced processing speed, described in Claim 14, and the tactile stimulus described in Claim 20 allow full functionality of the computer application while also providing an incentive to purchase the application. Here also, because of the difference in kind between the features described in Claims 14 and 20 and the type of features described in Allen, these claims would not have been obvious to those of ordinary skill in the art.

Claim 24

Similar reasoning supports the non-obviousness of the "unpleasant olfactory stimulus" described in Claim 24. Indeed, it is respectfully submitted that such a stimulus is counter-interactive. One of ordinary skill in the art would not normally consider designing a program that produces such a stimulus. Thus, it would not have been obvious to one of ordinary skill in the art to do this. The teachings of the present application, however, show why that is useful under certain circumstances.

In view of the above-discussed differences between Claims 1, 14, 17, 20 and 24 and Allen, and because of the advantages associated with those differences, these claims patentably distinguish over the prior art and are allowable. Claims 10-13 and 22-24 are dependent from Claim 1 and are allowable therewith; and Claims 15, 16, 25 and 26 are dependent from, and are allowable with, Claim 14. Similarly, Claims 18, 19, 27 and 28 are dependent from Claim 17 and are allowable therewith; and Claims 29 and 30 are dependent from Claim 20 and are allowable therewith. The Examiner is, accordingly, asked to reconsider and to

withdraw the rejection of Claims 1 and 10-20 under 35 U.S.C. §102, and to allow these claims and new Claims 22-30.

VIII. Conclusion

Allen does not disclose or suggest the specific ways that are described in Claims 1, 14, 17, 20 and 24 to degrade or diminish the performance or operation of a computer application. Accordingly, the rejection of these claims under 35 U.S.C. §103 is not proper. As indicated immediately above, the remaining claims are dependent from one of Claims 1, 14, 17 or 20 and are, thus, also allowable.

The Board of Appeals is, thus, respectfully asked to reverse the rejection of Claims 1, 10-20 and 22-30 under 35 U.S.C. §103.

Respectfully submitted,

Dated: February 22, 2005

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Enclosure: Appendix A

APPENDIX A

Claim 1: A system running in a central processing unit for changing the appearance and performance generated by a specified application, the system comprising:

a timer for measuring time; and

means, responsive to the timer, to change, after receipt of the specified application by the central processing unit, the appearance or performance generated by the specified application according to a timed procedure to encourage a user of the application to abandon this specified application and to purchase a new version of the specified application;

wherein the central processing unit is connected to a network to receive data therefrom over a bandwidth and the means to change the appearance or performance of the specified application includes means to degrade said network bandwidth.

Claim 10: The system as in Claim 1 where changes are obtained by manipulating drives in PC.

Claim 11: The system in claim 1 where users pay money or view advertisements to reduce or eliminate degradation.

Claim 12: The system in claim 11 where money is paid to any of: software manufacturer, seller, third party, or degradation service provider.

Claim 13: The system in claim 12 where the amount of degradation is related to the amount of money paid.

Claim 14: A method of operating a trial software application, said trial application being associated with a defined full application, said method comprising the steps of:

providing the trial application with a first set of instructions, embodied in the computer readable medium, for causing a computer to generate a main program; and

providing the trial application with a second set of instructions, embodied in the computer readable medium, for causing the computer to diminish, after receipt of the trial application by the computer, the performance of the main program over time and in accordance with a timed procedure in order to encourage a user of the computer to purchase said defined full application;

wherein the computer has a central processing unit having a processing speed, and the step of providing the trial application with a second set of instructions includes the step of using said second set of instructions to diminish the performance of the main program by degrading said processing speed.

Claim 15: A method according to Claim 14, wherein said subprogram begins to diminish the performance of the main program a defined period of time after the user begins to use the trial application.

Claim 16: A method according to Claim 15, wherein said subprogram gradually diminishes the performance of the main program over a given time starting at the end of said defined period of time.

Claim 17: A system for operating a trial software application on a computer, said trial application having a main program and being associated with a defined full application, said system comprising:

a timer for measuring time;

means for operating the main program to produce a defined performance;

means responsive to the timer for diminishing, after receipt of the trial application by the computer, the performance of the main program over time and in accordance with a timed procedure in order to encourage a user to purchase said defined full application;

wherein the computer is connected to a network to receive data therefrom over a bandwidth, and the means for diminishing the performance of the main program includes means to degrade said network bandwidth.

Claim 18: A system according to Claim 17, wherein said means for diminishing included means to begin to diminish the performance of the main program a defined period of time after the user begins to use the trial application.

Claim 19: A system according to Claim 18, wherein said means for diminishing includes means to diminish gradually the performance of the main program over a given time starting at the end of said defined period of time.

Claim 20: A program storage device readable by machine, tangibly embodying a program of instructions executable by the machine to perform method steps for encouraging a user to purchase a full version software application related to a trial version, said method steps comprising:

providing a user computer with the trial version;

allowing the user computer to use the full capacity of the trial version for a defined period of time to produce a defined performance;

after said defined period of time, after receipt of the trial version by the user computer diminishing the performance of the trial version in accordance with a timed procedure to encourage the user to purchase said full version;

wherein the step of diminishing the performance of the trial version includes the step of producing tactile stimulus.

Claim 22: A system according to Claim 1, wherein the central processing unit has a processing speed, and the means to change the appearance or performance of the specified application includes means to degrade said processing speed.

Claim 23: A system according to Claim 1, wherein the means to change the appearance or performance of the specified application includes means to produce tactile stimulus.

Claim 24: A system according to Claim 1, wherein the means to change the appearance or performance of the specified application includes means to produce unpleasant olfactory stimulus.

Claim 25: A method according to Claim 14, wherein the computer is connected to a network to receive data therefrom over a bandwidth, and the step of using said second set of instructions includes the step of using said second set of instructions to degrade said network bandwidth.

Claim 26: A method according to Claim 14, wherein the step of using said second set of instructions includes the further step of using said second set of instructions to produce tactile stimulus.

Claim 27: A system according to Claim 17, wherein the computer includes a central processing unit having a processing speed, and the means for diminishing the performance of the main program includes means to degrade said processing speed.

Claim 28: A system according to Claim 17, wherein the means for diminishing the performance of the main program includes means to produce tactile stimulus.

Claim 29: A program storage device according to Claim 20, wherein the computer is connected to a network to receive data therefrom over a bandwidth, and the step of diminishing the performance of the trial version includes the step of degrading said network bandwidth.

Claim 30: A program storage device according to Claim 20, wherein the computer includes a central processing unit having a processing speed, and the step of diminishing the performance of the trail version includes the step of degrading said processing speed.